<u>REMARKS</u>

This is a full and timely response to the outstanding final Office Action mailed August 10, 2007. Through this response, no claims have been amended. Reconsideration and allowance of the application and pending claims 1-3 and 5-47 are respectfully requested.

I.   **Claim Rejections - 35 U.S.C. § 103(a)**

    A.   **Statement of the Rejection**

Claims 1 – 3, and 5-47 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Pierre, et al.* ("*Pierre*," U.S. Pat. No. 6,678,463). Applicants respectfully traverse this rejection.

    B.   **Discussion of the Rejection**

The U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness according to the factual inquiries expressed in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The four factual inquires, also expressed in MPEP 2100-116, are as follows:

(A)   Determining the scope and contents of the prior art;

(B)   Ascertaining the differences between the prior art and the claims in issue;

(C)   Resolving the level of ordinary skill in the pertinent art; and

(D)   Evaluating evidence of secondary considerations.

Applicants respectfully submit that a *prima facie* case of obviousness is not established using the art of record.

Independent Claim 1

Claim 1 recites (emphasis added):

1.   A system for managing the allocation and storage of media content instance files in a hard disk of a storage device coupled to a media client device in a subscriber television system, comprising:
a memory for storing logic;
a buffer space in the hard disk for buffering media content instances as buffered media content instance files; and
a processor configured with the logic to track the size of permanent media content instance files and the buffered media content instance files to provide a numerical indication of an amount of available free space, such that the indication is independent of the buffer space.

Applicants respectfully submit that *Pierre* fails to disclose, teach, or suggest at least the above emphasized claim features, and that the documentary evidence ("Properties of Drive C in Windows Operating System," herein, *Properties document*) does not compensate for the deficiencies of *Pierre*. For instance, Applicants respectfully note that there is no indication (*e.g.*, effective date of reference) that the *Properties document* is "prior art" to Applicants' claims. As set forth above, *Graham* and USPTO guidelines (e.g., MPEP 2100-116) requires the determination of "the scope and contents of the prior art," and ascertaining "the differences between the prior art and the claims in issue." Additionally, Federal case law makes clear that, "[B]efore answering *Graham's* 'content' inquiry, it must be known whether a patent or publication is in the prior art under 35 U.S.C. § 102." *Panduit Corp. v. Dennison Mfg. Co.,* 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir.), *cert. denied,* 481 U.S. 1052 (1987).

Further, and related to the deficiency noted above, Applicants respectfully submit that without an identification of whether the *Properties document* is prior art to Applicants' claims, it cannot be concluded that "a numerical indication of an amount of available free space is well known in the art.'" (page 3, claim 1 (and all dependent claims to which the rejection of claim 1 has been incorporated on pages 4-9) discussion, final Office Action).

Further, even assuming *arguendo* that the *Properties document* could be established as prior art to Applicants' claims, the single disclosure of a document cannot be said to be "well-known."

Additionally, for at least the reason that the *Properties document* represents improper documentary evidence, the taking of Official Notice and/or allegations of well-known subject matter is improper. For instance, MPEP 2144.03 provides the following relevant guidelines as to the taking of Official Notice:

> It would <u>not</u> (no emphasis added) be appropriate for the examiner to take official notice of facts without <u>citing a prior art reference</u> (emphasis added) where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

> Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. <u>While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113.</u> Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. (emphasis added)

It is clear from the provisions noted above that evidence must be anticipatory to the claims at issue to serve as a basis for allegations of well-known or the taking of Official Notice.

In addition, even assuming *arguendo* that the *Properties document* could be construed as proper documentary evidence for purposes of Official Notice, Applicants respectfully traverse the taking of Official Notice and allegation of well-known art for the above reasons (use of improper documentary evidence), and also on separate grounds. For instance, the reasoning provided on pages 3-4 of the final Office Action are not predicated on sound technical and scientific reasoning, given the disparity of systems and methods represented by Applicants' claims, the *Properties document*, and *Pierre*. As provided in MPEP § 2144.03 (emphasis added):

> If applicant adequately traverses the examiner's assertion of
> official notice, *the examiner must provide documentary evidence*
> *in the next Office action* if the rejection is to be maintained. See
> 37 CFR 1.104(c)(2).

Applicants respectfully submit that in the context of the claim language (and given the disparities in systems noted above), such a finding of well-known art is improper given the reasons above, including the added complexity associated with such features as claimed. Accordingly, Applicants traverse the allegations with regard to well-known use and Official Notice. Because of this traversal, the Office must support its findings with proper documentary evidence, or withdraw the well-known/Official Notice determination.

Applicants also respectfully submit that the combination of *Pierre* and the *Properties document* is not obvious. Simply notifying a user that "there is insufficient space to record a program" (FIG. 7, reference numeral 140) provides no teaching or suggestion of the above-emphasized claim features. Further, the *Properties document* does not provide any teaching or suggestion that the disk space is for buffering content, and hence any conclusion as to free space indications that are buffer space-independent are simply based on improper hindsight reasoning.

Additionally, to implement the features of *Pierre* in combination with the *Properties document* would appear to necessitate changes to the *Properties document* (e.g., to handle buffered content) and *Pierre* (*e.g.*, user interface provisions relating to numerical indications of free space), which would tend to teach away from the combination.

Further, Applicants respectfully note that arguments presented above (and like arguments presented below) have been necessitated by the Official Notice as to the claim language in combination with *Pierre*, which was not presented in previous Office Actions and hence could not have been presented earlier.

Also, Applicants note that as of the date of the present response, there have been four Office Actions, all under different grounds for rejection (with only the 5/29/07 response having claim amendments).   Applicants respectfully note that MPEP 904.02 requires the following:

> In the examination of an application for patent, an examiner must conduct a thorough search of the prior art. Planning a thorough search of the prior art requires three distinct steps by the examiner: (A) identifying the field of search; (B) selecting the proper tool(s) to perform the search; and (C) determining the appropriate search strategy for each search tool selected. Each step is critical for a complete and thorough search.

Applicants respectfully request, in the interest of expediting examination on the merits in an economical and expeditious manner, full compliance with the provisions of MPEP 904.02.

For at least the reasons presented above, Applicants submit that claim 1 is allowable over the art of record, and hence respectfully request withdrawal of the rejection.

Because independent claim 1 is allowable over *Pierre*, dependent claims 2-3, 5-22, and 47 are allowable as a matter of law for at least the reason that the dependent claims 2-3, 5-22, and 47 contain all elements of their respective base claim. See, *e.g.*, *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Independent Claim 23

Claim 23 recites (emphasis added):

> 23.   A system for managing the allocation and storage of media content instance files in a hard disk of a storage device coupled to a media client device in a subscriber television system, comprising:
> a memory for storing logic;
>   a buffer space in the hard disk for continuously buffering media content instances as buffered media content instance files; and
>   a processor configured with the logic to track the size of permanent media content instance files and the buffered media content instance files, wherein the processor is further configured with the logic to provide a user interface, responsive to a user input, wherein the user interface provides the indication of available free space for permanently recording media content instances, wherein the permanently recorded media content instances are configured as the permanently recorded media content instance files, wherein the permanently recorded media content instance files can be deleted from the storage device, wherein the

user input is implemented with a remote control device, wherein the permanently recorded media content is from the buffer space, wherein the permanently recorded media content is a scheduled recording initially written to non-buffer space, wherein the permanently recorded media content is a scheduled recording initially written to non-buffer space, wherein the buffer space, the available free space, and permanently recorded space are located on the hard disk, wherein the buffer space and permanently recorded space are allocated from the free space on the hard disk, wherein the buffer space and permanently recorded space have physical locations on the hard disk, wherein the buffer space and the available free space is measured in units of hard disk space, wherein the processor is further configured with the logic to buffer analog broadcast media content instances, received at a communications interface, as digitally compressed media content instances, wherein the processor is further configured with the logic to buffer an analog signal received at a connector from a consumer electronics device, as a digitally compressed media content instance, wherein the processor is further configured with the logic to buffer digital broadcast media content instances, received at a communications interface, as digitally compressed media content instances, wherein the processor is further configured with the logic to buffer digital media-on-demand media content instances, received at a communications interface from a remote server, as digitally compressed media content instances, wherein the processor is further configured with the logic to buffer digital media content instances, received at a digital communications port from a local network, as digitally compressed media content instances, wherein the processor is further configured with the logic to buffer digital media content instances, received at a digital communications port from a local device, as digitally compressed media content instances, wherein the processor is further configured with the logic to determine the available free space after subtracting buffer space capacity from total disk space, wherein the processor is configured with the logic to reduce the available free space by the amount of the space used for the permanent media content instance files, wherein the processor is configured with the logic to increase the available free space by the amount of the space recovered from a deleted permanent media content instance files, wherein the indication of the free space available is configured in time of space available for the permanent media content instance files, *wherein the processor is further configured with the logic to provide the user interface that provides a numerical indication of an amount of available free space, such that the indication is unaffected by writes to and deletions from the buffer space.*

Applicants respectfully submit that for similar reasons presented above in association with claim 1, Applicants respectfully traverse the Official Notice/well-known allegation levied against claim 23 (by virtue of that application of the rejection to claims 1-22 to claim 23 as alleged on page 9) on page 9, and traverse the obviousness rejection overall

for similar reasons presented above for claim 1. Accordingly, Applicants respectfully request that the rejection be withdrawn.

Independent Claim 24

Claim 24 recites (emphasis added):

24. A method for managing the allocation and storage of media content instance files in a hard disk of a storage device coupled to a media client device in a subscriber television system, comprising the steps of:

buffering media content instances into buffer space as buffered media content instance files;

tracking the size of permanent media content instance files and buffered media content instance files; and

providing a numerical indication of an amount of available free space, such that the indication is independent of the buffer space.

Applicants respectfully submit that for similar reasons presented above in association with claim 1, Applicants respectfully traverse the Official Notice/well-known allegation levied against claim 24 (on page 10) and claims 25-45 (pages 10-14) and traverse the obviousness rejection overall for similar reasons presented above for claim 1. Accordingly, Applicants respectfully request that the rejection be withdrawn.

Because independent claim 24 is allowable over *Pierre*, dependent claims 25 – 45 are allowable as a matter of law.

Independent Claim 46

Claim 46 recites (emphasis added):

46. A method for managing the allocation and storage of media content instance files in a hard disk of a storage device coupled to a media client device in a subscriber television system, comprising the steps of:

continuously buffering media content instances as buffered media content instance files;

tracking the size of permanent media content instance files and the buffered media content instance files;

providing a user interface, responsive to a user input, wherein the user interface provides a numerical indication of an amount of available free space for permanently recording media content instances,

wherein the permanently recorded media content instances are configured as the permanently recorded media content instance files, wherein the permanently recorded media content instance files can be deleted from the storage device, wherein the user input is implemented with a remote control device, wherein the permanently recorded media content is from the buffer space, wherein the permanently recorded media content is a scheduled recording initially written to non-buffer space, wherein the permanently recorded media content is a scheduled recording initially written to non-buffer space, wherein the indication is unaffected by writes to and deletions from the buffer space, wherein the buffer space, the available free space, and permanently recorded space are located on the hard disk, wherein the buffer space and permanently recorded space are allocated from the free space on the hard disk, wherein the buffer space and permanently recorded space have physical locations on the hard disk, wherein the buffer space and the available free space is measured in units of hard disk space;

buffering analog broadcast media content instances, received at a communications interface, as digitally compressed media content instances;

buffering an analog signal received at a connector from a consumer electronics device, as a digitally compressed media content instance;

buffering digital broadcast media content instances, received at a communications interface, as digitally compressed media content instances;

buffering digital media-on-demand media content instances, received at a communications interface from a remote server, as digitally compressed media content instances;

buffering digital media content instances, received at a digital communications port from a local network, as digitally compressed media content instances;

buffering digital media content instances, received at a digital communications port from a local device, as digitally compressed media content instances;

determining the available free space after subtracting buffer space capacity from total disk space;

reducing the available free space by the amount of the space used for the permanent media content instance files; and

increasing the available free space by the amount of the space recovered from a deleted permanent media content instance files, wherein the indication of the free space available is configured in time of space available for the permanent media content instance files.

Applicants respectfully submit that for similar reasons presented above in association with claim 1, Applicants respectfully traverse the Official Notice/well-known allegation levied against claim 46 (on page 14) and traverse the obviousness rejection overall for similar reasons presented above for claim 1. Accordingly, Applicants respectfully request that the rejection be withdrawn.

CONCLUSION

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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